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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,772	01/25/2001	Roger Edwards	C005	5011

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PATENT DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA, CA 95050

EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 11/06/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,772

Applicant(s)

EDWARDS, ROGER

Examiner

Aravind K Moorthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 03 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-30 are pending in the application.
2. Claims 1-30 have been rejected.

Response to Amendment

3. The examiner approves the new title to the application.
4. The examiner approves changes to the drawings.
5. With regard to claims 2-12 and 14-25, the examiner withdraws 35 USC § 112 (2) rejection for antecedent basis.
6. With regard to claims 24 and 25, the examiner withdraws 35 USC § 112 (2) rejection for an omnibus type claim.
6. With regard to claims 13-23, the examiner withdraws 35 USC § 101 rejection for non-statutory subject matter.
7. The examiner approves amendment to the specification.

Response to Arguments

8. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

9. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim that depends from a dependent claim should not be separated by any claim that does not also depend from said dependent claim. It should be kept in mind that a dependent

claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Spitzenberger et al U.S. Patent No. 5,153,861.

As to claims 1 and 12, Spitzenberger et al discloses a method of copy protecting a digital audio compact disc carrying audio data and control data [column 2, lines 10-20]. Spitzenberger et al discloses that the control data is encoded onto the compact disc [column 2, lines 10-20]. Spitzenberger et al discloses that the copy protection method comprises rendering selected control data incorrect [column 2, lines 28-33]. Spitzenberger et al discloses that the selected

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control data being inaccessible to, or not generally read by, an audio player, such that an audio player is able to play the audio data [column 2, lines 21-27]. Spitzenberger et al discloses that the incorrect control data negatively effects the playability of audio in a data reader [column 3, lines 8-18].

As to claims 2 and 13, Spitzenberger et al discloses that the control data encoded on the compact disc that has been rendered incorrect is navigation data [column 2, lines 10-20].

As to claims 3 and 14, Spitzenberger et al discloses that A method according to Claim 2, wherein control data is provided in a Lead-In on the disc, and the incorrect control data is provided in the Lead-In, and identifies the position on the disc of the Lead-Out of the disc [column 8, lines 35-61].

As to claims 4 and 15, Spitzenberger et al discloses that the control data in the Lead-In that indicates the Atime at the start of the Lead-Out is rendered incorrect [column 7, lines 49-67].

As to claims 5 and 16, Spitzenberger et al discloses that the control data in the Lead-in shows the Atime at the start of the Lead-Out to be zero [column 7, lines 49-58].

As to claims 6 and 17, Spitzenberger et al discloses that the control data in the Lead-In has a value for the Atime at the start of the Lead-Out that occurs during a first audio track on the compact disc [column 7, lines 49-67].

As to claims 7 and 18, Spitzenberger et al discloses that the control data encoded on the compact disc defining the nature of the tracks is rendered incorrect, as discussed above.

As to claims 8 and 19, Spitzenberger et al discloses a method of copy protecting a digital audio compact disc carrying audio data and control data, as discussed above. Spitzenberger et al discloses that the control data is encoded onto the compact disc, as discussed above.

Spitzenberger et al discloses that the copy protection method comprising rendering selected control data incorrect, as discussed above. Spitzenberger et al discloses that the selected control data being inaccessible to, or not generally read by, an audio player, such that an audio player is able to play the audio data, as discussed above. Spitzenberger et al discloses whereas the incorrect control data negatively effects the playability of the audio data in a data reader, as discussed above. Spitzenberger et al discloses that the control data encoded on the compact disc defining the nature of the tracks is also rendered incorrect, as discussed above.

As to claims 9, 20, 24 and 29, Spitzenberger et al discloses that the data on the CD identifying the nature of the tracks incorrectly identifies each audio track as a data track [column 4, lines 31-38].

As to claims 10, 21, 25 and 30, Spitzenberger et al discloses that the compact disc that is rendered incorrect is data in the Table of Contents (TOC) of the compact disc [column 5, lines 31-45].

As to claims 11 and 26, Spitzenberger et al discloses that the control data encoded on the compact disc is altered, to render it incorrect, prior to mastering of the disc [column 2, lines 10-55].

As to claims 22 and 27, Spitzenberger et al discloses that the control data encoded on the compact disc that has been rendered incorrect is timing data [column 4, lines 39-51].

As to claims 23 and 28, Spitzenberger et al discloses that the control data encoded on the compact disc that has been rendered incorrect is navigation and timing data, as discussed above.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1373.

Aravind K Moorthy
October 31, 2003


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100